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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,603	12/19/2001	Napoleone Ferrara	GENENT.1516CP1	4344
23552	7590	10/07/2003	EXAMINER	
MERCHANT & GOULD PC			HUYNH, PHUONG N	
P.O. BOX 2903			ART UNIT	
MINNEAPOLIS, MN 55402-0903			PAPER NUMBER	

1644

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/027,603	<b>Applicant(s)</b> FERRARA ET AL.	
	<b>Examiner</b> Phuong Huynh	<b>Art Unit</b> 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-61 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

I. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Group 1640, Technology Center 1600.

II. Claims 1-61 are pending.

### *Election/Restrictions*

III. Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claim 1-11, 14-18, and 22-24, drawn to a specific **antagonist antibody**, a composition comprising said antibody, classified in Class 424, subclass 130.1.
2. Claims 11-13, and 20-22, drawn to a composition comprising an **EG-VEGF polypeptide**, classified in Class 424, subclass 185.1
3. Claims 11, and 20-22, drawn to a composition of matter comprising an **agonist of an EG-VEGF polypeptide** that is not an antibody, classified in Class 424, subclass 185.1
4. Claims 11, and 19-22, drawn to a composition of matter comprising an antagonist of an EG-VEGF polypeptide that is an **antisense molecule**, classified in Class 536, class 24.5.
5. Claims 11, 14, 17-18, and 20-22, drawn to a composition of matter comprising an **agonist of an EG-VEGF polypeptide** wherein the agonist is an **antibody**, classified in Class 424, class 130.1
6. Claims 25-31, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **stimulate phosphorylation of a specific MAP kinase** that involved in cell proliferation or survival, classified in Class 435, subclass 17

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7. Claims 25-31, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **inhibit phosphorylation of a specific MAP kinase** that involved in cell proliferation or survival, classified in Class 435, subclass 17
8. Claims 25-27, 32, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **stimulate cell proliferation**, classified in Class 435, subclass 7.21
9. Claims 25-27, 32, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **inhibit cell proliferation**, classified in Class 435, subclass 7.21
10. Claims 25-27, 33, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is to **stimulate chemotaxis**, classified in Class 435, subclass 7.21
11. Claims 25-27, 33, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is to **inhibit chemotaxis**, classified in Class 435, subclass 7.21
12. Claims 25-27, 34, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **stimulate angiogenesis**, classified in Class 435, subclass 7.21
13. Claims 25-27, 34, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **inhibit angiogenesis**, classified in Class 435, subclass 7.21
14. Claims 25-27, 35, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **stimulate cell differentiation**, classified in Class 435, subclass 7.21

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15. Claims 25-27, 35, and 37-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **inhibit cell differentiation**, classified in Class 435, subclass 7.21
16. Claims 25-27, and 36-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **stimulate endothelial cell fenestration**, classified in Class 435, subclass 7.21
17. Claims 25-27, and 36-41, drawn to a method for identifying a compound that modulates a biological activity wherein the activity is the ability to **inhibit endothelial cell fenestration**, classified in Class 435, subclass 7.21
18. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **stimulate phosphorylation of a specific MAP kinase** that involved in cell proliferation or survival, classified in Class 530, subclass 300
19. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **inhibit phosphorylation of a specific MAP kinase** that involved in cell proliferation or survival, classified in Class 530, subclass 300
20. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **stimulate cell proliferation**, classified in Class 530, subclass 350
21. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **inhibit cell proliferation**, classified in Class 530, subclass 350
22. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is to **stimulate chemotaxis**, classified in Class 530, subclass 317

23. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is to **inhibit chemotaxis**, classified in Class 530, subclass 317
24. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **stimulate angiogenesis**, classified in Class 530, subclass 352
25. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **inhibit angiogenesis**, classified in Class 530, subclass 352
26. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **stimulate cell differentiation**, classified in Class 530, subclass 331
27. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **inhibit cell differentiation**, classified in Class 530, subclass 331
28. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **stimulate endothelial cell fenestration**, classified in Class 530, subclass 350
29. Claim 42, drawn to a compound identified by the method that modulates a biological activity wherein the activity is the ability to **inhibit endothelial cell fenestration**, classified in Class 530, subclass 350
30. Claims 43-47, drawn to a method of inducing cell proliferation with **EG-VEGF**, classified in Class 435, subclass 7.21

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31. Claims 48-52, drawn to a method of inducing chemotaxis in cells with **EG-VEGF**, classified in Class 435, subclass 7.21
32. Claims 53-57, drawn to a method of enhancing cell survival with **EG-VEGF**, classified in Class 435, subclass 7.8
33. Claims 58-59, drawn to a method of inhibiting endothelial cell proliferation using a specific anti-EG-VEGF antibody, classified in Class 435, subclass 7.1
34. Claims 60-51, drawn to a method of inhibiting chemotaxis in endothelial cells using a specific anti-EG-VEGF antibody, classified in Class 435, subclass 7.1

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups 1-5, and 18-29 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the products as claimed differ with respect to their structure, binding specificity and physiochemical properties. Further, a prior art search also requires a literature search. It is a burden for the examiner to search more than one invention. Therefore, they are patentably distinct.

Inventions of Groups 6-17 and 30-34 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the methods of identifying compound versus the methods of inducing a specific biological activity using distinct products differ with their respect to their process steps and endpoints. Therefore, they are patentably distinct.

Inventions of Groups (1-5 and 18-29) and Groups (6-17 and 30-34) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products such as antibody agonist or antagonist can be used in materially different process such as treating a

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specific condition. The polypeptide can be used in binding/screening assays. The nucleic acid can be used in materially different process such as making polypeptide or transgenic animal. Therefore, they are patentably distinct.

4. Because these inventions are distinct for the reasons given above and the searches are not co-extensive, restriction for examination purposes as indicated is proper.
5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Huynh "NEON" whose telephone number is (703) 308-4844. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.
7. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Phuong N. Huynh, Ph.D.  
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October 3, 2003

  
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